

SECTION III—REMARKS

This amendment is submitted in response to the Office Action mailed August 25, 2004. Claim 1 is amended herein, and claims 5 and 6 are canceled. Claims 1-4, 7, 16-19 and 22 remain pending in the application. Applicants respectfully request reconsideration of the application and allowance of all pending claims in view of the above amendments and the following remarks.

Drawing Objections

The Examiner objected to Figures 1-4 of the drawings. According to the Examiner, these figures only show that which is old, and the Examiner therefore required that a legend such as --Prior Art-- be applied to these drawings. Applicants have enclosed with this amendment a replacement sheet of drawings in which Figures 1-4 have the legend requested by the Examiner. Applicants submit that this overcomes the Examiner's rejections.

Rejections Under 35 U.S.C. § 102

The Examiner rejected claims 1, 16 and 18-19 as anticipated under 35 U.S.C. § 102(b) by Japanese Patent No. JP09080246 to Shinobu ("Shinobu"). Applicants respectfully traverse the Examiner's rejections. A claim is anticipated only if each and every element, as set forth in the claim, is found in a single prior-art reference. MPEP § 2131; *Verdegaal Bros. v. Union Oil of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). As further explained below, Shinobu cannot anticipate these claims because it does not disclose every element and limitation recited therein.

Claim 1, as amended, recites a method combination including forming a cladding material over a substrate, lithographically patterning and etching the cladding material to obtain core regions and a spacing between the core regions that is made of the cladding material, filling the core regions with a core material, using a chemical-mechanical process to remove excess core material formed over the core regions and over the cladding material, and "forming another cladding material over the core regions and over the spacing." The Examiner alleges that Figure 4(b) of Shinobu anticipates this claim. The English abstract of Shinobu describes only what is found in Figures 3(a)-3(c), not figure 4. Without any written description of Figure 4(b), the Examiner relies solely on the drawing to reject the claim. Drawings and pictures can anticipate claims if they clearly show the claimed structure. MPEP § 2125; *In re Mraz*, 455 F.2d 1069 (CCPA 1972). However, the picture must show all the claimed structural features and how they

are put together. MPEP § 2125; *Jockmus v. Leviton*, 28 F.2d 812 (2d Cir. 1928). Figure 4(b) of Shinobu shows a layer 19 positioned over the cladding 13 and the cores 18. There is no disclosure, teaching or suggestion in the Figure regarding what material the layer 19 is made from, and the English abstract also does not explain what layer 19 is made from. Applicants therefore respectfully submit that Shinobu cannot anticipate claim 1, because the Figures do not clearly show a process combination including “forming another cladding material over the core regions and over the spacing.” Applicants submit that claim 1 is therefore allowable, and respectfully request withdrawal of the rejection and allowance of the claim.

Claim 16 recites a device combination including a spacing made of a first cladding material and formed by an etch process to remove portions of the first cladding material from core regions adjacent to the spacing, a core material filled into the core regions subsequent to removal of portions of the first cladding material from the core regions, and “a layer made of a second cladding material and formed over the core material and over the first cladding material, including over the spacing.” By analogy to the discussion above for claim 1, Applicants submit that Shinobu cannot anticipate this claim, and respectfully request withdrawal of the rejection and allowance of the claim.

Rejections Under 35 U.S.C. § 103

The Examiner rejected claims 2-4, 7, 17 and 22 under 35 U.S.C § 103(a) as obvious in view of, and therefore unpatentable over, Shinobu. Applicant respectfully traverses the Examiner’s rejections. If an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is also non-obvious. MPEP § 2143.03; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). As discussed above, claims 1 and 16, as amended, are in condition for allowance. Applicant therefore respectfully submits that claims 2-4 and 7 are allowable by virtue of their dependence on allowable claim 1, as well as by virtue of the features recited therein. Similarly, claim 17 and 22 are allowable by virtue of its dependence on allowable claim 16 and by virtue of the features cited therein. Applicant therefore respectfully requests withdrawal of the rejections and allowance of these claims.

Conclusion

Given the above amendments and accompanying remarks, all claims pending in the application are in condition for allowance. If the undersigned attorney has overlooked a teaching

in any of the cited references that is relevant to allowance of the claims, the Examiner is requested to specifically point out where such teaching may be found. Further, if there are any informalities or questions that can be addressed via telephone, the Examiner is encouraged to contact the undersigned attorney at (206) 292-8600.


Charge Deposit Account

Please charge our Deposit Account No. 02-2666 for any additional fee(s) that may be due in this matter, and please credit the same deposit account for any overpayment.

Respectfully submitted,

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Date: 11-24-04



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Enclosures: Postcard
Amendment transmittal, in duplicate
Replacement sheet with Figures 1-4